

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

TESSERA, INC.,

Plaintiff,

v.

ADVANCED MICRO DEVICES, INC., et.  
al.,

Defendant.

No. C 05-4063 CW

ORDER GRANTING  
DEFENDANTS' MOTION  
TO FILE  
SUPPLEMENTAL BRIEF  
AND PERMITTING  
PLAINTIFF TO FILE  
RESPONSE  
(Docket No. 1473)

AND ALL RELATED COUNTERCLAIMS

On June 16, 2014, Defendants STMicroelectronics, Inc. and STMicroelectronics N.V. filed a motion to submit a ten page supplemental brief addressing the Supreme Court's June 2, 2014 decision in Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120 (2014). In Nautilus, the Supreme Court reversed the Federal Circuit's decision and articulated a new standard on indefiniteness. Plaintiff Tessera, Inc. opposes the motion or, in the alternative, requests that it be afforded the opportunity to respond to the newly-asserted arguments.

By Defendants' own description, presently before the Court are: the parties' competing proposals for claim construction, Tessera's motion for summary judgment on indefiniteness, and Defendants' motion for summary judgment of non-infringement. The Supreme Court's new standard on indefiniteness impacts Tessera's motion for summary judgment on indefiniteness and Defendants' response to that motion. Thus, supplemental briefing on the issue is warranted.

1       However, Defendants' proposed supplemental brief not only  
2       rebutts Tessera's summary judgment motion, but also urges the Court  
3       to "grant summary judgment that the asserted claims of Tessera's  
4       patents are invalid as indefinite," which the Court construes as  
5       an affirmative summary judgment motion of indefiniteness raised  
6       for the first time. Docket No. 1473-1 at 8. If Defendants wish  
7       to make an additional summary judgment motion after briefing has  
8       concluded, they generally must show good cause for the argument's  
9       late inclusion. Tessera opposes the motion on much the same  
10      grounds, arguing that ST never raised an indefiniteness defense  
11      during fact or expert discovery and such a defense should be  
12      barred under Rule 37. Docket No. 1476 (citing Yeti By Molly Ltd.  
13      v. Deckers Outdoor Corp., 259 F.3d 1101, 1106 (9th Cir. 2001)).

14      Although ST should have made explicit its intention to bring  
15      an affirmative summary judgment motion and shown good cause, ST's  
16      justification for not bringing this motion sooner is readily  
17      apparent. The new indefiniteness standard might alter the  
18      indefiniteness findings on Tessera's patents reached by this Court  
19      and others. Because the new law emerged only after the parties  
20      completed summary judgment briefing, and Defendants sought leave  
21      to address the issue shortly thereafter, Defendants were justified  
22      in not disclosing this defense earlier. Yeti by Molly, Ltd., 259  
23      F.3d at 1106 (citing Fed. R. Civ. P. 37(c)(1)) ("The information  
24      may be introduced if the parties' failure to disclose the required  
25      information is substantially justified or harmless."). Allowing  
26      Defendants' new indefiniteness argument will be substantially  
27      harmless because Tessera themselves brought a motion on  
28

1 indefiniteness, and so both experts should already have examined  
2 the issue. Id.

3 Even though ST's motion for leave to file is not strictly  
4 proper procedurally, in the interest of efficiency, the Court  
5 admits Defendants' supplemental brief. Tessera may file a ten  
6 page supplemental brief in response no later than ten days after  
7 entry of this order. No replies will be permitted.

8 IT IS SO ORDERED.

9  
10 Dated: 6/30/2014

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CLAUDIA WILKEN  
United States District Judge